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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,626	05/31/2000	Zubair Mirza	602927.090085	4023

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NEW YORK, NY 10016

EXAMINER

SPISICH, MARK

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,626

Applicant(s)

MIRZA ET AL.

Examiner

Mark Spisich

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 11-13, 19-24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-18, 25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 May 2004 has been entered.

Election/Restrictions

2. Claims 11-13, 19-24 and 26 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

3. Claims 2, 3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 has been amended to recite that the second orientation is at least 10 degrees rearward of the first orientation. As such, claims 2-3 now essentially merely duplicate a limitation that is now in claim 1. Also, claim 6 now defines the second orientation in a broader manner than is now defined in claim 1 and thus is improper because a dependent claim must further limit the claim(s) from which it depends. Applicant should review the claims for any additional informalities.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hukuba (USP 5,406,664). The patent to Hukuba discloses a toothbrush comprising a handle (12), head (10) with bristles (14) extending from the head, a pivot joint (58) between the head and the handle and further wherein the head, upon the application of a predetermined force (P2) will automatically pivot from a first orientation (alpha 1) to a second orientation (alpha 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10,14-18,25 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Hukuba (USP 5,406,664). The patent to Hukuba discloses (with particular reference to figs 11-13) a toothbrush comprising a handle (12) and a head (10) with bristles (14) projecting from the head in a "forward" direction and wherein the head is pivoted (about 58) to the handle such that upon application of a force (P2) the head moves from a first orientation (alpha 1) to a second orientation (alpha 2) rearward

of the first. The drawings (fig 11) seem to show an angle of at least 10 degrees between the three angular positions of the head. For sake of argument, any such change (if any) would amount to an obvious choice of design. The particular force amount would be obvious to one of ordinary skill depending on the desired brushing force. With regard to claim 5, the head (10) of Hukuba could be placed in an orientation between location alpha 2 and alpha 3 in which it would be (1) at least 10 degrees from the first orientation and (2) freely pivotable. With respect to figs 11-13, which corresponds to the elected embodiment (fig 11) of the present application), Hukuba discloses a hinge including a pivot (58), a spring-biased detent (64).

Response to Arguments

8. Applicant's arguments filed 7 May 2004 have been fully considered but they are not persuasive. The present invention discloses numerous embodiments which all have an "inoperative" position upon the application of a predetermined force. The elected embodiment (figure 11) includes a pivot point (64) as well as a spring-biased ball (66) for retaining the head relative to the handle in each of two different orientations (corresponding to 67a and 67b). This structure is also found in figures 11-13 of Hukuba. In a broad sense, the "inoperative" position of the independent claims (as defined in the present specification) is merely an angular position rearward of the first position. By the definition provided by the present specification, the patent to Hukuba discloses the second "inoperative" orientation. Applicant is going to be hard-pressed, in the eyes of the examiner, to draft a generic claim which covers all of the disclosed embodiments. When interpreting the term "inoperative", the examiner has fully

considered the present specification. The arrangement of figs 11-12 of Hukuba works in the same manner as that of the elected embodiment (figure 11), i.e. the head (10) moves from position alpha 1 to alpha 2 upon the application of a predetermined force and the angle between these two positions is substantial and thus the second position of Hukuba is a "disabled" position just as much as in the present application. Just because applicant chose to describe the second position in a different manner does not change the fact that the second position of Hukuba is the same as that claim. It is further pointed out that the first and second orientations could just as easily be positions alpha 2 and alpha 3, respectively. The angle of fig 11 would appear to be well more than 10 degrees. The claims have been rejected under "103" simply for sake of argument. The angle (theta) of Hukuba that applicant mentions in the "remarks" is not the angular orientation of the head (10). The angle between the two positions of the head is shown in fig 11 (between alpha 1 and alpha 2 and between alpha 2 and alpha 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Spisich
Primary Examiner
Art Unit 1744

MS